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10/646,019	08/22/2003	Thomas Soares	CEN-002	9263

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RONALD CRAIG FISH, A LAW CORPORATION
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EXAMINER

CORRALES, JONATHAN E

ART UNIT	PAPER NUMBER
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2169

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/646,019	Applicant(s) SOARES ET AL.	
	Examiner Jonathan E. Corrales	Art Unit 2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/22/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the application filed on October 22, 2003.

Specification

2. The disclosure is objected to because of the following informalities:
 - Page 1, paragraph 3, line 1, the acronyms ERP and CRM are not initially written in full;
 - Page 1, paragraph 5, line 3, the acronyms DASD and NAS are not initially written in full;
 - Page 1, paragraph 6, line 1, the acronym WAN is not initially written in full;
 - Applicant is respectfully reminded of the arrangement of an application. (see MPEP 608.01(a)). Applicant has placed the summary of the invention after the brief description of the drawings. The summary of the invention should be placed before the brief description of the drawings;
 - On page 9, second line from the top, the applicant uses the trademark "LEGO." It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks;
 - On page 9, paragraph 1, line 3, the applicant uses the trademark "DELL" which should be capitalized (see the objection above for more details);

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- On page 9, third line from the top, the word "relationships" should be --relationships--; and
- On page 12, paragraph 2, line 4, the words "a hierarchy" should be --in a hierarchy--.

Although the some minor informalities were listed above, the list intended to be an exhaustive list of all informalities found within the disclosure of the instant application. The examiner respectfully reminds applicant to be mindful of any additional informalities that the examiner may have missed and correct them in the communication following this office action. With regard to acronyms not initially written in full, although the examiner has listed some occurrences of acronyms not initially written in full, the applicant must also be mindful of additional acronyms with the same deficiency. The list of acronyms not initially written in full is in no way exhaustive. The initial recitation of what the acronyms stand for is helpful for one of ordinary skill in the art to understand what certain concepts are. Acronyms can change or evolve over time to represent something different than what they were initially intended to represent, and for the sake of clarification the examiner respectfully requests that all acronyms, not initially written in full, be written in full in the communication following this office action.

Appropriate correction is required.

Drawings

3. The drawings are objected to because of the following informalities:

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- With regard to figure 1, the label for figure 1 is not clearly visible. Fig. 1 on the bottom of the page for figure 1 is not legible. The reference numbers for fig. 1 are also not clearly visible. Moreover, items 10, 12, and 14 are too dark for the labels inside of them to be visible;
- With regard to fig. 3A, there is a box with 4 references inside the box on the top left hand corner. This box is not a part of the flow chart. The examiner respectfully requests the applicant removes this box from the figure;
- Items referenced by numbers 108 and 199 in figure 6 are too dark. The labels inside of these items are not clearly visible;
- With regard to Fig. 7B, the item labeled "end" does not have a reference number; and
- With regard to Fig. 6, item labeled "RFS's & SR's" does not have an accompanying number.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 5 and 7-11 are objected to because of the following informalities:
- In line 8 of claim 5, the word "which" is repeated;
 - In line 1 of claim 7, the word "apparatus" should be --process--;
 - In line 1 of claim 8, the word "apparatus" should be --process--; and
 - In line 2 of claim 8, the word "defining" should be --identifying--. Moreover, the words "or the" should be --or defining the--.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1 – 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The process of claim 1 contains steps which are optionally recited limitations that only occur in the event that a particular event occurs (i.e., a particular icon is selected). However, if none of the events occur the default result of claim 1 is step 1, "displaying a

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plurality of icons or menu choices [...].” The result of merely displaying icons or menu choices is not a tangible result. The claimed invention as a whole must be produce a tangible result (i.e., defining services listed in an IT services catalog) in order for a user of the invention to realize the usefulness of the invention. That is, it must produce a “useful, concrete and tangible result (emphasis added).” State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Claims 2-8 depend on claim 1, and as a result of their dependency they inherit the deficiency of the claim it/they depend(s) on. Since the dependent claim(s) do not address the deficiencies stated above, they are rejected for at least the same reasons.

With regard to claim 9, claim 9 contains steps which are optionally recited limitations that only occur in the event that a particular event occurs (i.e., a particular icon is selected). However, if none of the events occur the default result of claim 9 is step 1, “displaying a plurality of icons or menu choices [...].” The result of merely displaying icons or menu choices is not a tangible result. The claimed invention as a whole must be produce a tangible result (i.e., defining services listed in an IT services catalog) in order for a user of the invention to realize the usefulness of the invention.

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That is, it must produce a “useful, concrete and tangible result (emphasis added).” State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Claims 10 – 11 depend on claim 9, and as a result of their dependency they inherit the deficiency of the claim it/they depend(s) on. Since the dependent claim(s) do not address the deficiencies stated above, they are rejected for at least the same reasons.

With regard to claim 12, claim 12 contains steps which are optionally recited limitations that only occur in the event that a particular event occurs (i.e., a particular icon is selected). However, if none of the events occur the default result of claim 12 is step 1, “displaying a plurality of icons or menu choices [...]”. The result of merely displaying icons or menu choices is not a tangible result. The claimed invention as a whole must be produce a tangible result (i.e., defining services listed in an IT services catalog) in order for a user of the invention to realize the usefulness of the invention. That is, it must produce a “useful, concrete and tangible result (emphasis added).” State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value,

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as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Claims 13 – 14 depend on claim 12, and as a result of their dependency they inherit the deficiency of the claim it/they depend(s) on. Since the dependent claim(s) do not address the deficiencies stated above, they are rejected for at least the same reasons.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, applicant recites the limitation “displaying a plurality of icons or menu choices which can be selected [...]” (claim 1, line 3). The recitation of “can be” renders claim 1 indefinite.

Claims 2 - 8 depend on claim 1, and as a result of their dependency they inherit the deficiency of the claim it/they depend(s) on. Since the dependent claim(s) do not address the deficiencies stated above, they are rejected for at least the same reasons.

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Claims 9 and 12 suffer from the same deficiencies as described above for claim 1 and are rejected for at least the same reasons. Claims 10-11 and 12-14 depend on claims 9 and 12 respectively, and as a result of their dependency they inherit the deficiency of the claim it/they depend(s) on. Since the dependent claim(s) do not address the deficiencies stated above, they are rejected for at least the same reasons.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by

Baharami (US 2004/0078777 A1).

With regard to claim 1, Baharami teaches displaying a plurality of icons or menu choices which can be selected to start the process of creating a new service (i.e., business process), or modifying a preexisting service and/or resource, or define cost information or define a service action (fig.2-3); if an icon or menu choice is selected to start the process of creating a new service, displaying one or more displays soliciting information from a user to name the service and define the fields and contents thereof for a data structure which defines an instance of said service and define attributes of each field including validation constraints and validation formulas, and receiving and

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storing any data entered by a user in response to said displays (fig. 3, item 220); if an icon or menu choice is selected to start the process of defining a relationship, displaying one or more displays soliciting information as to which preexisting service or IT resource to which the data structure of a service will point and receiving and storing any data entered by a user in response to said displays so as to allow a hierarchy of services to be defined by entry of said pointers(fig. 3, item 202); and if an icon or menu choice is selected indicating a user wishes to define a service action, displaying one or more displays that solicit the name of the service action to be defined and to define the fields and contents thereof for a data structure which defines an instance of said service action and attributes for each field, and receiving and storing any data entered by a user in response to said displays, said one or more displays also allowing a user to enter pointer data which defines relationships between service actions in a hierarchy of service actions to create, modify or destroy instances of services (section [0035], lines 6-7 and 9-10).

With regard to claim 2, Baharami teaches structure allows text, numbers of formulas to be stored in the field as if the field were a spreadsheet cell, and further comprising the steps of determining if a user is a high level or low level user and, if a high level user has logged in who needs the assistance of building blocks or primitives, displaying a palette of building blocks which the user can use to define services or service actions or relationships there between, and receiving user input regarding which building blocks the user wishes to combine and how the user wishes to combine them,

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and then using the data in the data structures of the building blocks to populate the fields of the data structure of the service or service action the user is attempting to define (section [0036]).

With regard to claims 3 and 4, Baharami teaches allowing attributes to be defined for each field which define whether the field is configurable, whether the data of a field can be overridden by new data entered by a user, and which define constraints for the field in the form of formulas that define maximum and/or minimum limits for a field or which define a property which must be true about the content of said field (section [0033], lines 12-15).

With regard to claim 5, Baharami teaches a database model which defines the information stored in a data structure that defines an instance of said service (section [0020], lines 1 – 7); one or more relationship fields each of which contains a pointer to another IT service and/or resource which said IT service is an extension of or which will be utilized in said IT service (section [0020], line 9, [0035], lines 6-7 and 9-10); one or more cost information fields each of which records formulas that are used to compute the cost of implementing or using said service (section [0020], lines 1 – 7); and one or more service action fields, each of which contains a pointer to a data structure which defines an instance of a service action, each service action defining an action that can be taken when a service is used such as create, modify or delete (section [0029], lines 1-2).

With regard to claim 6, Baharami teaches defining one or more models that define the information that is stored in a database or data structure which define an

instantiation of said service action ([0028], lines 1 – 4); defining one or more relationship fields which contain pointers to other service actions or resources so as to define a hierarchy of service actions if any (fig. 2, items 120-140); defining one or more fields which contain formulas for computing the cost to perform said service action one time (section [0029], line 11); defining one or more fields that contain schedule information or a formula to compute an approximate time to complete a service action and/or how soon said service action can start (fig. 6, item 512; section [0026], line 13; section [0029], line 9); defining a field that contains a pointer to a fulfillment workflow data structure and defining said fulfillment workflow structure in the form of a specification of the steps that need to be performed to accomplish said service action and the order, if any, in which the steps need to be performed (fig. 3, item 220); defining one or more fields that contain validation logic in the form of constraints on the values of one or more fields and/or validation formulas to determine whether a value in a field satisfies a constraint (section [0029], line 10); and defining one or more fields that contain an approval workflow in the form of a specification of the steps that need to be performed to accomplish approval by management to carry out said service action (fig. 2, item 132).

With regard to claim 7, Baharami teaches fulfillment workflow includes the steps of defining the physical and/or logical resources which will be required to accomplish each step in said workflow (fig. 6, item 508; section [0029], lines 9-10; and section [0057]).

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With regard to claim 8, Baharami teaches defining the steps of defining the particular IT professional or the skill set needed by an IT professional to accomplish each manual task in said fulfillment workflow (section [0032], lines 9 - 12).

With regard to claims 9 and 12, the limitations of claim 9 and 12 are rejected in the analysis of claim 1 above, and these claims are rejected on that basis.

With regard to claims 10 and 11, the limitations of claim 10 and 11 are rejected in the analysis of claim 5 above, and these claims are rejected on that basis.

With regard to claims 11 and 14, the limitations of claim 11 and 14 are rejected in the analysis of claim 6 above, and these claims are rejected on that basis.

Conclusion



11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See form PTO-892 attached hereto.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan E. Corrales whose telephone number is 571-270-1283. The examiner can normally be reached on Monday - Thursday 6:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JEC
February 6, 2007 

Jonathan E Corrales
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